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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,822

04/28/2006

Takao Wada

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08/18/2009

CASELLA & HESPOS  
274 MADISON AVENUE  
NEW YORK, NY 10016

EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,822	<b>Applicant(s)</b> WADA, TAKAO	
	<b>Examiner</b> Jacqueline F. Stephens	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/5/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/5/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 6/5/09 have been fully considered but they are not persuasive. Applicant argues Reising does not teach a stretchable elastic feature in the front and back waist regions. However, as previously argued by the Examiner, Reising teaches the stretchable waist can be present on the front, back, or both waist regions (col. 6, lines 31-41). Applicant argues nothing in Reising suggests an arrangement where "a length of the back region in the waist direction when the back region is stretched is longer than a maximum length of the abdominal region that can be achieved in the waist direction". However, Applicant's argues are not related to structure, but to a function of the article. Due to the presence of the elastic feature in the back waist region, a user can stretch the back waist region longer than a maximum length of the abdominal region. Figure 1 shows the back waist region is almost equal in length to the abdominal region when no force is applied. As to the new limitations of the

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independently-made abdominal region and independently-made back regions, these limitations are directed to a process of making the article and are discussed below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reising et al. USPN 4681580.

4. As to claim 1, Reising teaches a disposable wearing article 10 comprising a back region 30 having extensibility in the waist direction and provided with stopper members 38 at both ends in the waist direction; an abdominal region 31 provided with flap portions 39, 40, 41 at both ends in the waist direction; and an absorber 14 that bridges between the back region and the abdominal region, wherein a length of the back region in the waist direction when stretched would be longer than a maximum length of the abdominal region that can be achieved when the abdominal region is not stretched and the length of the back region in the waist direction when no force is applied from an outside is almost equal to the length of the abdominal region in the waist direction when no force is applied to the abdominal region from the outside (Figure 1, col 10, lines 53-64)). Reising teaches the stretchable waist can be present on the front, back, or both waist regions (col. 6, lines 31-41). In the case of the waistband 18 present in the back

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region, the back region is stretched longer than a maximum length of the abdominal region as claimed.

As to the limitations of the independently-made abdominal region and independently-made back regions, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Additionally, Reising discloses the claimed invention except for back waist region and abdominal regions are integral. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reising to have a separate back waist regions and abdominal regions since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

As to claim 4, the back region includes a web for outer surface 16 , a web for inner surface 12, and an elastic member 75/76 between the outer and inner surface

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As to claim 5, a trimmed portion is provided on an inner edge of each of the both ends of the back region and an inner edge of the flap portions (Figure 1, edges 70, 17)

As to claim 6, a slanting portion is provided on an inner edge of each of the both ends of the back region and an inner edge of the flap portions (where leg curves are present, Figure 1)

As to claims 7 and 8, the stopper members 38 are temporarily held on the abdominal region to form the disposable wearing article into an underpants-shape, and the back region and the abdominal region are joined at an inside or outside from the stopper member (col. 10, lines 53-64). The limitations as to how the pants are joined are directed to an intended use of the garment. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

As to claim 10, Reising teaches the stretchable waist can be present on the front, back, or both waist regions (col. 6, lines 31-41). In the case of the waistband 18 present in the back region, the abdominal region has substantially no extensibility in the waist direction.

As to claim 9, Reising discloses the present invention substantially as claimed.

However, Reising does not teach the claimed length of the flap portions. However, in

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*Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacqueline F Stephens/  
Primary Examiner, Art Unit 3761